

REMARKS

I. Status of the Claims

Claims 1-12 were rejected by the Examiner. Claims 1-12 remain pending. Applicants request amendment of claims 1, 11, and 12 to recite that the hard caramel is a hard caramel with improved stability in storage. This amendment is fully supported throughout the specification, for example, on page 3, lines 1-8, but especially line 4. These amendments, therefore, do not introduce any new matter and do not require any additional search.

II. Information Disclosure Statement

The Examiner's statement that the application does not have an Information Disclosure Statement filed on March 21, 2002, is acknowledged. Although Applicant's files indicate the Information Disclosure Statement and references were filed on March 21, 2002, Applicants also were able to identify only a portion of this submission in the Office's image file wrapper. Accordingly, Applicants submit as part of this response the stamped postcard showing receipt of the Information Disclosure Statement and references by the Office on March 21, 2002. Applicants also resubmit copies of this Information Disclosure Statement and the references so that they may be scanned to complete the Office's image file wrapper. Applicants respectfully request the Examiner consider the March 21, 2002, IDS and return the initialed PTO Form 1449.

III. Rejection of Claims 1-12 under 35 U.S.C. § 103(a)

According to the Office, claims 1-12 are unpatentable over the teachings of U.S. Patent No. 5,578,339 to the Kunz *et al.* ("*Kunz*") in combination with U.S. Patent No.

6,248,386 to Willibald-Ettle *et al.* (“Willibald-Ettle”). (Final Office Action, page 2.) The Office states that Applicants arguments have been fully considered, but are not persuasive because both *Kunz* and *Willibald-Ettle* teach “conventional use of 1,1-GPM and sorbitol in the production of candy/caramel.” (*Id.* at page 3.) The Office concludes that “[I]n the absence of a showing to the contrary, Applicant is using known components to obtain no more than expected results.” (*Id.*)

In order to properly reject a claim as obvious in view of a combination of prior art references, the Office has the burden of establishing a *prima facie* case that:

(1) . . . the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) . . . the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success. Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure.

In re Vaeck, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991) (citations omitted). For the reasons presented in detail in the response filed November 3, 2004, Applicants maintain that the Office has failed to satisfy its burden of establishing that the claims are *prima facie* obvious over the prior art. It is only after the Office has established a *prima facie* case that Applicants have any obligation to provide evidence of nonobviousness, such as unexpected results. See M.P.E.P. § 2142. Nevertheless, because the Specification itself already provides evidence of unexpected results, Applicants will address the Office’s assertion that “Applicant is using known components to obtain no more than expected results.” (Final Office Action, page 3.)

Neither *Kunz* nor *Willibald-Ettle*, relied upon by the Office in its obviousness rejection, teach that the stability of a hard caramel can be improved by selecting

particular percentages of 1,1-GPM and sorbitol. *Kunz* instead teaches that it is desirable to eliminate the sorbitol, and teaches how to accomplish its removal. See, e.g., *Kunz*, Example 3 at columns 6 to 7, and Example 7 at columns 8 to 9. Further, *Kunz* teaches at column 1, lines 49-52, that mixtures of 1,6-GPS or 1,6-GPM with other sugar alcohols or sugars in the presence of sorbitol yields unsatisfactory products that are sticky. *Willibald-Ettle* also does not teach the selection of specific ranges of 1,1-GPM and sorbitol. Instead, *Willibald-Ettle* is limited to providing a new process for producing a hard caramel. See, e.g., *Willibald-Ettle*, column 1, lines 1-2 and 38-44.

In contrast, the Specification discloses that it is possible to improve the stability of a hard caramel by selecting a particular range of 1,1-GPM concentrations in combination with a particular range of sorbitol concentrations. (Specification at page 2, first and second full paragraphs.) As summarized in the first paragraph on page 3 of the Specification, this improved stability in storage, due to the especially low water uptake and lower tendency towards recrystallization of the claimed hard caramels compared to known hard caramels, was surprising. Certainly nothing in *Kunz* suggests that there would be a particular combination of 1,1-GPM and sorbitol concentrations that would lead to this effect, because otherwise *Kunz* would not have taught, as noted *supra*, that it was desirable to eliminate the sorbitol. Likewise, nothing in *Willibald-Ettle* provides such a suggestion.

The Specification provides further evidence that the improved stability observed using concentrations of 1,1-GPM and sorbitol with the claimed ranges was unexpected. First, the experiments summarized in the Figures show that the unwanted water intake and color change of the hard caramels depends upon both the amount of 1,1-GPM and

the amount of sorbitol in the hard caramels. Second, the Specification also shows that this effect is not observed when the 1,1-GPM content is less than or greater than the limited range defined by the claims. For example, the Specification on page 11, third paragraph, notes that hard caramels containing only 50 to 51 wt% 1,1-GPM, a concentration below that recited in the claims, rapidly recrystallize, even though they contain 1.4 to 3.5 wt% sorbitol. Hard caramels containing a 1,1-GPM content of more than 60 wt%, the upper limit recited in the claims, have a tendency to crystallize on cooling. (Specification, sentence bridging pages 12-13.) Further, the Specification discloses that when the concentration of 1,1-GPM is controlled, hard caramels that include sorbitol have a lower tendency towards recrystallization. (Specification, page 12, last paragraph.)

The Specification, therefore, demonstrates that hard caramels containing concentrations of 1,1-GPM and sorbitol outside of the recited ranges do not result in properties that impart improved stability to the hard caramel. It is only after Applicants' surprising finding that the ordinary artisan could then appreciate the importance and desirability of the recited concentration ranges. Applicants respectfully submit that, even had the Office established a *prima facie* case of obviousness (for the reasons of record, the Office has not met this burden), the unexpected results described in the Specification provide sufficient evidence of nonobviousness.

CONCLUSION

Applicants respectfully request entry of this Amendment under 37 C.F.R. § 1.116. They submit that the proposed amendments do not raise new issues or necessitate the undertaking of any additional search of the art by the Office. Further, Applicants submit that the entry of the amendment would place claims 1-12 in condition for allowance, or would place the application in better form for appeal, should the Office dispute the patentability of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account no. 06-0916.

Respectfully submitted,

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